

Applicants: Arlindo L. Castelhana et al.
Serial No.: 10/718,280
Filed : November 20, 2003
Page 4

Remarks

Claims 42-50 and 55-60 were pending in the subject application. By this Amendment, Applicants have canceled claims 42-50. Accordingly, claims 55-60 are currently pending.

Rejection under 35 U.S.C. §112, first paragraph

In the May 18, 2007 Office Action, the Examiner rejected claims 42-50 because the specification, while being enabling for treating a subject afflicted with a disease associated with an A1 adenosine receptor via inhibiting the activity of the A1 adenosine receptor, does not reasonably provide enablement for treating specific diseases listed in claim 42.

In response, without conceding the correctness of the Examiner's argument or relinquishing their right to pursue patent protection for any canceled subject matter, Applicants have canceled claims 42-50.

Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Double Patenting

On page 3 of the May 18, 2007 Official Action, the Examiner rejected claims 55, 57-60 under the doctrine of obviousness-type double patenting as allegedly unpatentable over claim 8 of U.S. Patent Application No. 10/497,451. The Examiner alleged that the conflicting claims are not patentably distinct from each other.

Applicants: Arlindo L. Castelhana et al.
Serial No.: 10/718,280
Filed : November 20, 2003
Page 5

In response, Applicants attach hereto as **Exhibit 1** a Terminal Disclaimer which disclaims the terminal portion of the statutory term of any patent granted on the subject application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 of any U.S. Patent issued from U.S. Patent Application No. 10/497,451. Accordingly, the double patenting rejection is now moot with respect to U.S. Patent Application No. 10/497,451.

Under 37 C.F.R. §1.321(b), a terminal disclaimer must be accompanied by the fee set forth in 37 C.F.R. §1.20(d). Under 37 C.F.R. §1.20(d), the fee for filing a terminal disclaimer is ONE HUNDRED THIRTY DOLLARS (\$130.00) and a check including this amount is enclosed.

Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Claim Objection

The Examiner objected to claim 56 for being dependent upon a rejected base claim - claim 55. In view of the above filing of terminal disclaimer, Applicants respectfully request that the Examiner reconsider and withdraw the objection.

Applicants: Arlindo L. Castelhana et al.
Serial No.: 10/718,280
Filed : November 20, 2003
Page 6

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed \$460.00 fee for a two-month extension of time and \$130.00 fee for filing a terminal disclaimer, is deemed necessary in connection with the filing of this amendment. However, if any other fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Gary J. Gershik 10/18/07
John P. White
Reg. No. 28,678
Gary J. Gershik
Reg. No. 39,992

Date

Gary J. Gershik

John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

EXHIBIT 1

Applicant: Arlindo L. Castelhana et al.

Application Serial No.: 10/718,280

Filed: November 20, 2003